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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/925,548	08/08/2001	Shoukat Dedhar	KINE001CIP4	5127

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EXAMINER

CHEN, SHIN LIN

ART UNIT	PAPER NUMBER
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1632

DATE MAILED: 05/29/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/925,548

Applicant(s)
Dedhar et al.

Examiner
Shin-Lin Chen

Art Unit
1632



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3-4-03 and 5-9-03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above, claim(s) 5-7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s): _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s): _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 1632

DETAILED ACTION

1. Applicant's election with traverse of group I, claims 1-4, and SEQ ID No. 16 in Paper No. 7 is acknowledged. The traversal is on the ground(s) that it is improper to divide each of the SEQ ID Nos because those sequences are short fragments from SEQ ID No. 1. Applicants further argue that groups I and II should be rejoined because the term "distinct" means that two or more subjects are related and are patentable over each other. This is not found persuasive because each oligonucleotide sequence is structurally and functionally independent and distinct. Each oligonucleotide sequence has a unique nucleotide sequence that targets a different and specific region of a gene, and each oligonucleotide, upon binding to a gene sequence, can function as a primer or a probe for different purposes, or can functionally modulates (increases or decreases) the expression of the gene and to varying degrees. Furthermore, a search of more than one oligonucleotide sequence presents an undue burden on the Patent and Trademark Office due to the complex nature of the search and corresponding examination of more than one. The oligonucleotide can be used to as probe for screening or detection of a target nucleotide sequence or can be used as a primer for PCR amplification. Such uses are different from using the oligonucleotide as an antisense sequence for inhibiting gene expression *in vitro* or *in vivo*. Thus groups I-II require separate search and are patentably distinct from each other.

The requirement is still deemed proper and is therefore made FINAL.

Art Unit: 1632

2. Claims 5-7 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Applicant timely traversed the restriction (election) requirement in Paper No. 7.

Applicants' new sequence listing submitted 5-9-03 has been entered. Since the SEQ ID Nos 13-109 have been amended to read as SEQ ID Nos. 3-99, the elected SEQ ID No. 16 corresponds to SEQ ID No. 6 of the new sequence listing. Claims 1-7 are pending and claims 1-4 and SEQ ID No. 6 are under consideration.

Oath/Declaration

3. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MEP. §§ 602.01 and 602.02.

The oath or declaration is defective because:

No reference to the provisional application No. 60/009,074, filed 12-21-95, whose priority has been claimed in the first sentence of the specification.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 1632

5. Claim 1 recites the limitation "the sequence" in line 1. There is insufficient antecedent basis for this limitation in the claim. It is unclear whether "the sequence" refers to the oligonucleotide or other sequence. Claims 2-4 depend on claim 1 but fail to clarify the indefiniteness.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1 and 2 are rejected under 35 U.S.C. 102(a) as being anticipated by Hillier et al., 1995 (Genbank Accession No. R14703, p. 4-5).

Claims 1 and 2 are directed to an oligonucleotide comprising at least 18 nucleotides that is complementary to an mRNA encoding human integrin-linked kinase or SEQ ID No. 1.

Hillier teaches a human cDNA sequence, Genbank Accession No. R14703, which is 99.7% identical to bases 289-630 of SEQ ID No. 1 that encodes the human integrin-linked kinase. The complementary strand of Genbank Accession No. R14703 would have an oligonucleotide that comprises at least 18 nucleotides and is complementary to SEQ ID No. 1. Thus, claims 1 and 2 are anticipated by Hillier.

Art Unit: 1632

8. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Ozaki et al., 1993 (Genbank Accession No. D13973, p. 12-13).

Claims 1 and 2 are directed to an oligonucleotide comprising at least 18 nucleotides that is complementary to an mRNA encoding human integrin-linked kinase or SEQ ID No. 1.

Ozaki teaches a DNA sequence, Genbank Accession No. D13973, which is 100% identical to bases 1763-1789 of SEQ ID No. 1 that encodes the human integrin-linked kinase. The complementary strand of Genbank Accession No. D13973 would have an oligonucleotide that comprises at least 18 nucleotides and is complementary to SEQ ID No. 1. Thus, claims 1 and 2 are anticipated by Ozaki.

Conclusion

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shin-Lin Chen whose telephone number is (703) 305-1678. The examiner can normally be reached on Monday to Friday from 9 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Reynolds can be reached on (703) 305-4051. The fax phone number for this group is (703) 308-4242.

Application/Control Number: 09/925,548

Page 6

Art Unit: 1632

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-0196.

A handwritten signature in cursive script, appearing to read 'Shin-Lin Chen'.

Shin-Lin Chen, Ph.D.